

Application No.: 09/520,004

6

Docket No.: 61755(51035)

REMARKS

Claims 2-19 are pending in the application. Claims 20-21 are added. Support for claims 20-21 appear throughout the specification and claims as originally filed. Applicants request entry and consideration of the request, amendments and response herein.

Applicants note that the statement in the Advisory Action failed to address each argument of Applicants' previous Supplemental Response filed November 16, 2004 and those amendments were not entered. Therefore, Applicants' have reiterated those amendments and arguments in this response.

Amendment of any claim herein is not to be construed as acquiescence to any of the rejections/objections set forth in the instant Office Action, and was done to expedite prosecution of the application. Applicants make these amendments without prejudice to pursuing the original subject matter of this application in a later filed application claiming benefit of the instant application, including without prejudice to any determination of equivalents of the claimed subject matter. Support for these amendments appears throughout the specification and claims as filed. No new matter is introduced by these amendments.

Rejection under 35 U.S.C. 112, first paragraph

Claims 3, 8 and 10 are rejected as failing to comply with the written description requirement. Applicants traverse.

Claims 3, 8 and 10 are amended to recite "40%", "5%", and "50 ppm", respectively. Support for these amendments appears in the specification and original claims 3, 8 and 10 as filed. As such, Applicants respectfully request withdrawal of the rejection.

Rejection under 35 U.S.C. 112, second paragraph

Claims 2-19 are rejected as being indefinite. Applicants traverse.

BOS2_475757_1.DOC/JHSI

Application No.: 09/520,004

7

Docket No.: 61755(51035)

Claim 2 is rejected as allegedly lacking antecedent basis for the phrase "the pH of the process medium." Applicants traverse on the grounds that the process medium inherently has a pH; however, Applicants have amended claim 2 to recite "the pH of the aqueous process medium", for which antecedent basis unambiguously appears in the claim. Applicants request withdrawal of the rejection.

Claims 3, 4, 8, 18 and 19 are rejected as allegedly indefinite because of the use of the term "substantially". Applicants traverse.

Applicants have amended claims 3, 4, 8, 18 and 19 to recite claim language as originally presented (e.g., "about"). Moreover, Applicants note that the term "about" has been found to be definite, particularly in the context of a limitation that lends itself to a clear assessment of infringement through the use of measurable means (e.g., stopwatch for a time limitation). See, *Ex Parte Eastwood*, 163 USPQ 316 (Bd. App. 1968); *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F2d 1540, 220 USPQ 303 (Fed. Cir. 1983); MPEP 2173.05(b)(A). Applicants also submit that art cited in Form PTO-892 in Paper 11 (Office Action mailed April 30, 2003) as "Haas Isohop Product Information" was improperly cited. No publication date was provided in Form PTO-892 in Paper 11 and there is no indication provided that the citation was, in fact, published prior to Applicants' March 6, 2000 filing date. For the aforementioned reasons, Applicants submit that claims 3, 4, 8, 18 and 19 are not indefinite and request withdrawal of the rejection.

Rejection under 35 U.S.C. 103(a)

Claims 2-10, 12 and 13 are rejected as obvious over Bayside (Newsletter of the Bayside Brewers Club, May 1996) in view of Haas Products and Applications ("Products"). *Applicants traverse the rejection, and now reiterate the argument that was not addressed in the Advisory Action.*

BOS2_475757_1.DOC/JIISI

Application No.: 09/520,004

8

Docket No.: 61755(51035)

First, Applicants submit that the rejection based on Products is improper as Products is not citable prior art. Applicants' filed this application on March 6, 2000. The effective prior art date of Products in the Action (and accompanying Form PTO-892) is identified as 2001. As such, Applicants' filing date predates the prior art date of Products and citing of Bayside is improper. Furthermore, even if asserted to show properties of "isohop", the citation is insufficient to support the rejection.

Products is also improperly cited if intended to demonstrate that ISOHOP® as used in Example 5 of Applicants' specification is necessarily the identical material to the material designated "isohop" in Bayside. No such extrapolation can be made. Bayside provides no indication of the nature of their "isohop" material other than it is an "isomerized hop extract" with an "alpha-acid rating of 30%". Bayside provides no teaching or suggestion that their isohop material is in a salt form (while Applicants' claimed methods incorporate salt forms), and provides no motivation for salt forms. In fact, the description in Bayside that the material is "already in the correct form" can be construed to indicate that it is the acid form that is being used in the Bayside isohop material, not Applicants' salt forms.

Furthermore, Bayside in and of itself fails to establish a *prima facie* case of obviousness of Applicants' claimed methods. To establish a *prima facie* case, three requirements must be met: (a) there must be a suggestion or motivation to modify the reference or combine the teachings; (b) there must be a reasonable expectation of success; and (c) the prior art references must teach or suggest all claim limitations. MPEP 2143. Applicants submit that at least one of these elements is not met and a *prima facie* case of obviousness is not established.

Bayside provides no description or suggestion of Applicants' claimed methods of using salt forms, either generally, or specifically for improved processes for controlling microorganisms. In fact, as previously discussed, the description in Bayside that the material is "already in the correct form" can be construed to indicate that it is the acid form that is being used in the Bayside isohop material. Additionally, Bayside fails to provide any

R052_475757_1.DOC/11151

Application No.: 09/520,004

9

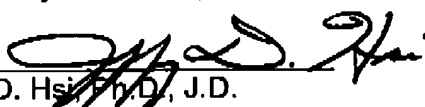
Docket No.: 61755(51035)

teaching or suggestion of an "improved process for controlling microorganisms." Thus, Bayside at least fails to provide a suggestion or motivation to modify Bayside to arrive at Applicants' methods using salt forms, fails to teach or suggest all claim limitations (e.g., use of salt forms, controlling microorganisms) and therefore fails to meet criteria (a) and (c) above. A *prima facie* case of obviousness is thus not established. As such, Applicants respectfully request that this rejection be withdrawn.

In view of the above amendment, Applicants believe the pending application is in condition for allowance. As the Request for Continued Examination is filed within two months of the Notice of Appeal (i.e., up to and including January 31, 2005, as January 29, 2005 is a Saturday), Applicants believe that no fee other than that for the request is due. The Director is hereby authorized to charge or credit any deficiency in the fees filed, asserted to be filed or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Deposit Account No. 04-1105, under Order No. (51035)61755.

Dated:

Respectfully submitted,

By 
Jeffrey D. Hsieh, Ph.D., J.D.
Registration No.: 40,024
EDWARDS & ANGELL, LLP
P.O. Box 55874
Boston, Massachusetts 02205
(617) 439-4444
Attorney for Applicants

BOS2_475757_1.DOC/J1151